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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/596,399

Filing Date: February 26, 2007

Appellant(s): YAMEN, SONER

Roger S. Burleigh
(Reg. No. 40,542)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/2/2010 appealing from the Office action mailed 3/2/2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:
Claims 1-8, and 9.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The patent number of the Enola reference listed by the Appellant is incorrect and should read Einola et al. (U.S. Patent No. 6771964 B1). The Appellant's statement of the grounds of rejection to be reviewed on appeal is correct with corrected reference listed above.

Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

US 6,771,964 B1	Einola et al.	08-2004
US 2004/0045447 A1	Rasanen et al.	04-2002
EP 1,257,141 A1	Lescuyer et al.	11-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows: (*See MPEP Ch. 2141*)

- a. Determining the scope and contents of the prior art;
 - b. Ascertaining the differences between the prior art and the claims in issue;
 - c. Resolving the level of ordinary skill in the pertinent art; and
 - d. Evaluating evidence of secondary considerations for indicating obviousness or nonobviousness.
2. **Claim 1, 2, 3, 4, 7, 8, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Einola et al., US Pat No. 6771964 B1. in view of Rasanen, Juha., US Pub No. 20020045477 A1**

Re claim 1, Einola discloses a method of a node of a communications network comprising at least a first access network and a second access network for enabling a user equipment to access said communications network , wherein the first and second access networks have at least a partially overlapping service

area, and wherein the user equipment located in a partially overlapping service area can be transferred from the first to the second access network (col 2, lines 55 – 64, where Einola discloses a handover (transfer of service) from an overlapping serving and neighborhood network (first and second access network); col 3, lines 13 – 15, a multi mode mobile station capable of communicating with different wireless networks), said method comprising the following steps:

receiving in a node an indication of a request for transferring at least one user equipment from said first access network to said second access network (col 2, line 65 – col 3, line 12, provided with information (indication of a request to transfer at least one user equipment) ... may be handed over to another network; also see col 3, lines 38 – 65, message (indication) is sent to the serving wireless network (first access network);,

checking a transfer permission parameter value associated to a user equipment, determining that the transfer permission parameter value indicates that a transfer of the associated user equipment is permitted (col 3, line 66 – col 4, line 2, permission for the user to utilize the neighboring wireless network),

determining that the transfer permission parameter value indicates that the user equipment belongs to a group of user equipment, for which a preferred access network has been defined (col 3, line 66 – col 4, line 2; col 6, lines 24 – 35 Einola discloses that preference parameter include GSM preferred, implies that user

equipment belongs to a GSM group of equipment that GSM preferred access networks is defined), and

initiating, based on the determination, the transfer of the user equipment from the first to the second access network (col 3, line 31 – 34). Einola discloses the claimed invention including that the MSC is a core network node (col 2, line 65) but does not explicitly disclose the BSC as a core network node. Rasanen in analogous art discloses a method in a core network of a communication, comprising a first access network and a second access network, for enabling a user equipment to access said communication network, wherein the first and second access networks have at least a partially overlapping service area, and wherein the user equipment located in a partially overlapping service area can be transferred from the first to the second access network (abstract, fig 1). Rasanen further discloses that MSC and BSC are of the core network (paragraph [38]) and has MSC (core node) analyzing request for transferring a user equipment and initiates the handover (paragraph [75]). It would therefore have been obvious to a person having ordinary skills in the art, at the time of the invention was made, to incorporate the teaching of Rasanen into the disclosure of Einola, having a core node disclosed by Rasanen performing all the steps disclosed by Einola so as to efficient interwork between different radio access network (paragraph [16]).

The rejection of claim 1 is incorporated herein. Claims 2, 3, 4 depend on claim 1 and only further limitations will be addressed below.

Re claim 2, Einola in view of Rasanen discloses that the access network operates according to the standards defined for Global System for Mobile Communication, Wide-band Code Division Multiple Access (fig 1, ref 12, 28, Einola disclose a GSM and UMTS network)

Re claim 3, Einola in view of Rasanen discloses that the group of user equipment for which a preferred access network has been defined comprises user equipment with service capability limited to services with correspond to services supported on the second network (col 6, lines 24 – 38, from the disclosure of Einola, when the serving network (first access network) is a GSM network, and the preference parameter of UMTS preferred)

Re claim 4, Einola in view of Rasanen discloses that the group of user equipment for which a preferred access network has been defined comprises user equipment associated with service capabilities limited to services which correspond to services supported by the second network (col 3, line 66 – col 4, line 2, permission of the user; col 6, lines 24 – 41, subscriber's preferred connection properties and other subscription data)

Re claim 7, it is drawn to the apparatus by the corresponding method claim 1 and is rejected for the same reasons as above.

The rejection of claim 7 is incorporated herein. Claim 8 depends on claim 7 and only further limitations will be addressed below.

Re claim **8**, it is drawn to the apparatus by the corresponding method claim 1 and is rejected for the same reasons as above.

Re claim **10**, it is drawn to the apparatus by the corresponding method claim 1 and is rejected for the same reasons as above

- 3. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Einola et al., US Pat No. 6771964 B1 in view of Rasanen, Juha., US Pub No. 20020045477 A1, as applied in claim 1 above, and further in view of Lescuyer, Pierre., European Pub No. 1257141 A1.**

The rejection of claim 1 is incorporated herein. Claims 5 and 6 depend on claim 1 and only further limitations will be addressed below.

Re claim **5**, Einola in view of Rasanen discloses wherein the group user equipment for which a preferred access network has been defined comprises user equipment associated with a subscription for which services are permitted (col 3, line 66 – col 4, line 2; col 6, lines 24 – 41). Einola is silent on the services not supported by the first network. Lescuyer in analogous art discloses a method of operating at least a first and second access networks where the mobile phone sends a indication of a request for transfer of at least one user equipment to the first access network and the first network decides and initiate transfer based on the request (see abstract) so as to allow change of RAT even between uncoordinated radio access networks (paragraph [11]). Lescuyer further discloses that a mobile may be able to detect the pilot or beacon or the presence of a HIPERLAN local area network and the user decides to switch to this network

if the current download rate is too slow on the current system or the file is too big and the HIPERLAN alternative (service that is not supported by the first network) is likely to provide a faster solution (paragraph [13]). It would have been obvious to a person having ordinary skills in the art, at the time of the invention, to incorporate the teaching of Lescuyer into the disclosure of Einola, to have services not supported by the first network so as to allow change of RAT even between uncoordinated radio access networks.

Re claim 6, the combined teaching of Einola in view of Rasanen and further in view of Lescuyer, as a whole, discloses that the group of user equipment for which a preferred access network has been defined comprises user equipment with service capacities corresponding to services (Einola: col 6, lines 24 – 41) that are not supported by the first network (paragraph [13], the file is too big and the HIPERLAN alternative is likely to provide a quicker solution).

(10) Response to Argument

- 1. Claims 1-4, 7, 8 and 10 are patentable over Einola in view of Rasanen**
 - a. Appellant argues on page 5, lines 4 - 11, that Einola does not disclose that a core network node checks the transfer permission parameter associated to the user terminal and determination whether handover of the call of the mobile station is to be performed.
 - b. In response to Appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re*

Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In accordance with Office action, Einola reference was not relied on solely to show a core network node performing said functionalities but relied in combination with Rasanen reference to show a core network node (MSC) performing said functionality (Rasanen: paragraph [83], MSC checking transfer parameter; paragraphs [75] and [84], MSC initiating transfer). Thus, the combination of Einola and Rasanen teaches that a core network, i.e., MSC, checks the transfer permission associated to the user terminal and determination whether handover of the call of the mobile is to be performed.

- c. Appellant argues that Einola does not teach a core network node (eg an MSC) that performs the functions of determining that a transfer permission parameter indicates that a transfer of an associated user equipment is permitted and that the user equipment belongs to a group of user equipments for which a preferred access network has been defined.
- d. In response, the Examiner respectfully disagrees with Appellant's argument. Appellant argument is misleading since Einola teaches a permission of a user (transfer parameter) to utilize another network is stored in the subscription data and further that the MSC (core network node) makes a determination based on the capability of the MS, retrieved subscription data (transfer parameter) and send a command to the BSC indicating whether the connection may or may not be routed to another

network. Einola teaches that the command is a Network Preference Parameter which indicates subscriber preference for networks (indicates that the user equipment belongs to a group of equipment, for which a preferred access network has been defined (col 3, line 66 - col 4 line 2; col 6, lines 1 – 41). Since clearly the MSC commands the BSC to change networks, the determination of the transfer permission parameter indicates that a transfer of an associate user equipment is permitted and the user equipment belongs to a group of user equipments for which a preferred access network has been defined is performed by the MSC.

- e. Appellant argues on page 6, lines 1 - 5, that the Examiner is looking to the teaching of Rasanen as teaching that functionalities performed in the BSC as core network node and that teaching of Rasanen that BSC is a core network node is not technically correct.
 - f. In response, the Examiner respectfully disagrees with Appellant's argument. The Examiner's position is that the functionalities of Einola when combined with Rasanen are performed by core network node (MSC) (see Rasanen, paragraphs [75], [83], [84]). Appellant's argument that the teaching of Rasanen of a BSC being a core network is technically incorrect is therefore moot, since Rasanen teaches that an MSC performs said functionalities.
2. **Claims 5 and 6 are patentable over Einola in view of Rasanen and Lescuyer**

- a. Appellant argues that Examiner has not pointed to any teaching in Lescuyer that would overcome the deficiency in the teaching of Einola and Rasanan and therefore claim 1 is obvious over Lescuyer.
- b. Examiner has shown that there is no deficiency in the teaching of Einola and Rasanan as set forth above and therefore the rejection of claims 5 and 6 is proper.

The remainders of the pertinent topics for argument are presented in the appropriate rejection above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
/OPIRIBO GEORGEWILL/
Examiner, Art Unit 2617

Art Unit: 2617

Conferees:

/George Eng/

Supervisory Patent Examiner, Art Unit 2617

/Kent Chang/

Supervisory Patent Examiner, Art Unit 2617